

DOCKET NO: 257253US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
BERND ZASCHKE, ET AL. : EXAMINER: COONEY, J. M.  
SERIAL NO: 10/507,315 :  
FILED: SEPTEMBER 10, 2004 : GROUP ART UNIT: 1796  
FOR: GRAFT POLYOLS WITH A :  
BIMODAL PARTICLE SIZE  
DISTRIBUTION AND METHOD FOR  
PRODUCING GRAFT POLYOLS OF THIS  
TYPE, IN ADDITION TO THE USE  
THEREOF FOR PRODUCING  
POLYURETHANES

REPLY BRIEF

SIR:

The following is a reply to the examiner's answer of March 11, 2010.

*The Examiner Recognizes That The Claims Are Not Indefinite*

The appealed rejection under 35 U.S.C. §112, second paragraph states on page 2:

“Applicants’ claims are confusing as to intent because it can not be determined what degree of overlap in particle size distribution are intended to be included by the claim limitation ‘the peaks of the large and small particles...do not overlap.’ ”

Thus, the claim language identified by the examiner as indefinite is the term “the peaks of the large and small particles...do not overlap.”

None the less, page 6 of the Examiner’s answer states “Confusion in the claims **does not reside in what is meant by ‘overlap,’...**”(emphasis added). As the examiner recognizes that the phrase in question does not create any confusion, (e.g. is not indefinite), the

examiner's rejection for indefiniteness must be withdrawn<sup>1</sup>. The very claim language previously identified in his assertion of indefiniteness is now recognized as not indefinite.

While the examiner continues to question whether one of ordinary skill in the art can determine the beginning or ending of a peak and when overlap of peaks would begin or end, appellants have not claimed their invention in terms of a peak beginning or a peak end. Appellants have claimed their invention in terms of there being a bimodal distribution and the peaks not overlapping. The occurrence of no overlap between peaks is the measure by which appellants' have claimed their invention. The examiner has recognized that it may have been possible to describe a bimodal distribution with peaks having a beginning and an end, appellants have not described their invention in such terms. Appellants have defined their invention by using the clear term of peaks which "do not overlap." Since the metes and bounds of the term "do not overlap" is clear to those of ordinary skill in the art, and recognized as such by the examiner, the claims are not indefinite. Thus, the examiner commits reversible error by rejection the claims as indefinite using language which is not in the claims.

In view of the errors made by the examiner, his conclusion as to indefiniteness and obviousness are in error and must be reversed.

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<sup>1</sup> The examiner's conclusion is consistent with the opinion evidence of Dr Daniel Freidank.